Application/Control Number: 10/086,102   Docket No.: 2001-0370
Art Unit: 2625

REMARKS

Reconsideration and allowance in view of the foregoing amendments and the

following remarks are respectfully requested. Claims 8 - 12 are cancelled and new claims 30

- 34 are added. No new matter is added.

Rejection of Claims 8 - 12 under 35 U.S.C. § 101

The Examiner has rejected claims 8 - 12 under 35 U.S.C. § 101 as being dependent on

claim 8 which contains non-statutory subject mater. Applicants cancel claims 8 - 12 without

prejudice or disclaimer and present new claims 30 - 34 for Examination. These claims do not

use the "computer program" language and Applicants submit that these claims conform to

Section 101.

Rejection of Claims 1-2, 5-7, 13-14, 17-19, and 22-27 under 35 U.S.C. § 102(e):

Claims 1-2, 5-7, 13-14, 17-19, and 22-27 are rejected under 35 U.S.C. Section102(e)

as being anticipated by Karczewicz et al. (U.S. 2003/008185 0 A1) ("Karczewicz").

Applicants traverse this rejection and submit that Karczewicz fail to teach each claim

limitation.

We first turn to claim 1. Claim 1 recites a method for coding image data in which the

constructed single entity is coded as an integer using an arithmetic coder wherein the values

of the transform coefficients are coded in any fixed order. The Examiner equated this

teaching with paragraph 24, lines 16 - 27 of Karczewicz. However, this portion of

Karczewicz actually teaches away from the present limitation wherein he teaches that "In

arithmetic coding a group of symbols, for example the run and level values for a block of

quantized transform coefficients, are coded as a floating point decimal number."

7

Application/Control Number: 10/086,102   Docket No.: 2001-0370
Art Unit: 2625

Therefore, rather than using arithmetic coding to code the single entity as an integer,

Karczewicz teach that it should be coded as a floating point decimal number. As is known in

the art, a floating point decimal number is a specific format of representing numbers, such as

123.4E-5 (where E5 represents 10^{-5}) which equals .001234, clearly not an integer.

Therefore, since Karczewicz fails to teach coding a single entity as an integer, Applicants

submit that this reference fails to teach each limitation of claim 1 and that claim 1 is

patentable and in condition for allowance.

For the same reasons set forth above, Applicants submit that claims 2, 5-7, 13-14, 17-

19, and 22-27 are patentable and in condition for allowance.

Rejection of Claims 3-4, 10, 15-16, 20-21 and 28-29 under 35 U.S.C. § 103(a)

The Examiner has also rejected claims 3-4, 10, 15-16, 20-21 and 28-29 under 35

U.S.C. Section 103(a) as being unpatentable over Karczewicz in view of Morihara et al.

(U.S. Patent No. 6,542 640 ("Morihara"). Applicants traverse this rejection and submit that

one of skill in the art would not be motivated to combine these references.

To establish a *prima facie* case of obviousness, the Examiner must meet three criteria.

First, there must be some motivation or suggestion, either in the references themselves, or in

the knowledge generally available to one of ordinary skill in the art, to combine the

references. Second, there must be a reasonable expectation of success, and finally, the prior

art references must teach or suggest all the claim limitations. The Examiner bears the initial

burden of providing some suggestion of the desirability of doing what the inventor has done.

"To support the conclusion that the claimed invention is directed to obvious subject matter,

either the references must expressly or impliedly suggest the claimed invention or the

examiner must present a convincing line of reasoning as to why the artisan would have found

8

Application/Control Number: 10/086,102   Docket No.: 2001-0370
Art Unit: 2625

the claimed invention to have been obvious in light of the teachings of the references." MPEP
2142.

If the examiner determines there is factual support for rejecting the claimed invention
under Section 103, the Examiner must then consider any evidence supporting the
patentability of the claimed invention, such as any evidence in the specification or any other
evidence submitted by the applicant. The ultimate determination of patentability is based on
the entire record, by a preponderance of evidence, with due consideration to the
persuasiveness of any arguments and any secondary evidence. *In re Oetiker*, 977 F.2d 1443,
24 USPQ2d 1443 (Fed. Cir. 1992). The legal standard of "a preponderance of evidence"
requires the evidence to be more convincing than the evidence which is offered in opposition
to it. With regard to rejections under Section 103, the Examiner must provide evidence which
as a whole shows that the legal determination sought to be proved (i.e., the reference
teachings establish a *prima facie* case of obviousness) is more probable than not. MPEP
2142.

With these principles in mind, Applicants submit that when the entire teachings of
each reference are considered for their suggestive power to combine, it becomes clear that the
preponderance of the evidence leads away from their combination. The Examiner states that
Karczemicz and Morihara are each in the same field of endeavor and thus are "combinable."
Applicants note that the "mere fact that references can be combined or modified does not
render the resultant combination obvious unless the prior art also suggests the desirability of
the combination." MPEP 2143.01 (emphasis in original). Therefore, without conceding the
point, even if Karczemicz and Morihara are combinable, there still must be a suggestion to do
so.

Applicants submit that when one learns of the focus of each reference, it becomes
clear that there is no suggestion or motivation to combine. Karczemicz focuses on an

9

invention for image coding. The images that are coded are typically still images or video

images. See, e.g., Paragraphs [0001], [0002], [0008]. Karczemicz notes that the ITU-T

recommendation standard H.26L is the latest in video coding standards with particular goals

for bit rates and certain characteristics for the coding standard. Paragraph [0043]. It is

simply clear that Karczemicz focuses on a standards-related invention for video coding.

In contrast, as noted by the Examiner, Morihara's invention focuses on a data

compression apparatus that relates to character trains in non-English languages such as

Japanese and Chinese. See, e.g., Col. 1, lines 7 - 16; col. 2, lines 59 - 67, col. 7, lines 45 - 51.

In short, Morihara's entire focus is to enable the coding of characteristics in languages such

as Japanese, Chinese and so forth from documents. They desire to realize a high processing

speed for documents containing those languages. Col. 2, lines 40 - 49.

Applicants submit that one of skill in the art would not be motivated to combine a

coding method from Morihara's document data compression disclosure into Karczemicz

where he focuses on a video-coding standard. There are many differences in the technical

requirements for each context. Karczemicz must deal with color and motion and all of the

processing requirements for a video standard. In contrast, Morihara's challenge is in

complex language representations (Japanese, Chinese) in documents. There are no motion or

color issues presented to Morihara. While both these references generally deal with data

compression, they diverge in their teachings and technical requirements between video

coding and complex language processing. Therefore, Applicants submit that, based on the

preponderance of the evidence, one of skill in the art would not find motivation to combine

these references.

For example, col. 2, lines 14 - 17 of Morihara mention semi-adaptive coding for

dividing in accordance with an appearance frequency obtained by first scanning all of

character trains. Karczewicz do not deal with "character trains" and do not perform a first

10

Application/Control Number: 10/086,102   Docket No.: 2001-0370
Art Unit: 2625

scanning of character trains. Therefore, if a semi-adaptive coding technique was used for

coding languages such as Japanese and Chinese, where is the motivation to one of skill in the

art to use that technique for video coding? We would submit that it would be difficult to

sustain an argument for motivation based on the differing teachings of each of the references.

Claim 10 has been canceled rendering that rejection moot.

Accordingly, Applicants submit that claims 3-4, 15-16, 20-21 and 28-29 are

patentable and in condition for allowance.

CONCLUSION

Having addressed all rejections and objections, Applicants respectfully submit that the

subject application is in condition for allowance and a Notice to that effect is earnestly

solicited.

Respectfully submitted,

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11